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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,790	07/05/2000	FUJIO MORI	2000-0938A	2735

7590 06/01/2005
WENDEROTH LIND & PONACK
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SUITE 800
WASHINGTON, DC 20006

EXAMINER

BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

ML

Office Action Summary**Application No.**

09/582,790

Applicant(s)

MORI, FUJIO

Examiner

Kevin M Bernatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-43 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22-43 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Amendment

1. Amendments to the specification and claims 22, 23, 39, 41 and 43, filed on March 7, 2005, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 22 – 28, 33 – 36 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (JP 09-300397 A) for the reasons of record as set forth in Paragraph No.'s 6 – 7 of the Office Action mailed on September 7, 2004. See provided English Translation of JP '397 A.

Regarding the amended language clarifying the method by which the test is performed, the Examiner notes that these amended limitations do not change the Office's position regarding the performance of the prior art product. Specifically, the Office maintains it's position that the product disclosed by Mori et al. is substantially identical to applicants' disclosed invention and would appear to be a *prima facie* case of obviousness with regard to the claimed "characteristics", especially the embodiment disclosed as application example 3 (having a thickness of 450 μm , hence meeting the claimed thickness limitations). It has long been held that where claimed and prior art products are identical or substantially identical in structure or composition, or are

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produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established and the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess characteristics of claimed products where the rejection is based on inherency under 35 USC 102 or on *prima facie* obviousness under 35 USC 103, jointly or alternatively.

Therefore, the *prima facie* case can be rebutted by **evidence** showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). The Examiner notes that there is presently no evidence of record that the disclosed product would not necessarily meet the claimed property limitations, especially application example 3 which is deemed the closest prior art embodiment presently of record.

4. Claims 29 – 32, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. as applied above, and further in view of Lau et al. (U.S. Patent App. No. 2001/0020047 A1) for the reasons of record as set forth in Paragraph No. 8 of the Office Action mailed on September 7, 2004.

5. Claims 39 - 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. as applied above, and further in view of Kitamura et al. (JP 04-075085 A) for the reasons of record as set forth in Paragraph No.'s 10 – 11 of the Office Action mailed on September 7, 2004. See provided English Translation of JP '085 A.

Response to Arguments

6. The rejection of claims 22 - 43 under 35 U.S.C § 112 – 1st Paragraph

The rejection of claims 22 - 43 under 35 U.S.C § 112 – 2nd Paragraph

The above noted rejections have been withdrawn because applicant(s) amendment(s) have set forth new limitations (e.g. amended language of claims 22, 23, 39, 41 and 43) no longer anticipated, nor rendered obvious, by the above noted rejection.

7. The rejection of claims 22 - 43 under 35 U.S.C § 103(a) – Mori et al., alone or in view of various references

Applicant(s) argue(s) that “because various types of methyl methacrylate materials are different from one another in terms of structure and composition, because various types of ABS material are different from one another in terms of structure and composition, and because the decorating sheet as recited in claim 22 is sought for a purpose not discussed in JP ‘397, it is respectfully submitted that there is no reason to believe that the insert film of JP ‘397 is identical or substantially identical in structure or composition to the decorating sheet” as claimed. The Examiner respectfully disagrees.

The Examiner notes that JP ‘397 A must be read in view of the knowledge of one of ordinary skill in the art of insert sheets/artificial wood grain products. As such, the Examiner notes that one of ordinary skill in the art would readily appreciate that while there are a wide variety of MMA and ABS materials, only a narrow subset of these materials would be capable of being used for the disclosed insert material. Specifically,

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Mori et al. teach a MMA that is solid at room temperature and capable of being molten at a temperature of ~220 – 250 °C without degrading (*Paragraphs 0044 – 0066*). The ABS is taught to be capable of withstanding molding at 120 °C for at least 5 minutes and a pressure of 5 kg/cm², wherein the final product is clearly a solid material at room temperature (i.e. a decorating sheet). Hence the selection of possible choices for the material are not infinite, but are deemed a fairly narrow subset of these materials.

In addition, the Examiner notes that the disclosed tests are arguably the basis of novelty of applicants' invention and even though the field of endeavor is different between applicants' invention and the invention of Mori et al., it is impossible to know whether the broad, generic structure recited in the base claims would cover prior art inventions outside applicants' field of endeavor. I.e. there is no evidence of record that the claimed "characteristics" are narrow limitations exclusive to applicants' field of endeavor or broad, sweeping limitations capable of reading on a wide variety of "sheets" having a substrate and backing layer. Applicants are invited to present evidence measuring the claimed characteristics of an insert sheet made according to the Mori et al. invention and capable of use as intended by Mori et al. or add additional structural limitations to the present claims to better distinguish structurally over the prior art of record. Applicants are reminded that unsubstantiated attorney arguments are not *evidence*.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

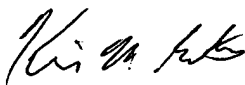
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB
May 27, 2005


Kevin M. Bernatz, PhD
Primary Examiner